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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,660	11/22/1999	EDWARD J. PETRUS		8939

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EDWARD J PETRUS
3413 SPANISH OAK DR
AUSTIN, TX 78731

EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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2166

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/444,660

Applicant(s)

PETRUS, EDWARD J.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Claims 1-10 are presented for examination in this Non-Final Office Action.

The following outline is provided to advise the Applicant on the suggested format and content of each section in a patent application.

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject

matter of the claimed invention. This item may also be titled "Technical Field."

- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural

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indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: --Method of Determining a Dietary Supplement Profile for an Individual--.

2. The disclosure is objected to because of the following:

The description of prior art in the specification (page 4, line 21-page 5, line 6) should be included in the "Background of the Invention" section of the application as indicated in the "Content of the Specification" (section (e)2) cited in this Office Action.

The Applicant's description of incorporating data from Laboratory Studies into the claimed process/method in the specification (page 3, lines 15-17) conflicts with the method/process as illustrated in Figure 1. In specification, the Applicant states that Laboratory Studies data are added to the computer database (reference #2). Figure 1

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indicates that data from the Laboratory Studies are added to the dietary supplement profile (reference number 3)

Also, the Examiner suggests that the Applicant use more detail in describing the claimed invention in the "Brief Summary of the Invention". Further suggestions on the format and appropriate content of the Summary of the Invention are described in the "Content of the Specification" (section f) cited in this Office Action.

Appropriate correction is required.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because the Applicant uses legal phraseology (e.g. "comprises") and implied terminology (e.g. "This invention *relates*. . .") that should not be used in the abstract. Furthermore, the explanation of the claimed invention in the abstract is unclear and awkwardly worded. For example, the Applicant seems to misplace the phrase describing the type of information included in the dietary supplement profile. The abstract now reads: ". . . an individual **of vitamins, minerals, amino acids** . . . ". Also, it is unclear to the Examiner which steps are included in the

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claimed method/process and how the addition of information from the lab studies and from the physical examination relates to the claimed method/process. Correction is required. See MPEP § 608.01(b).

Drawings

5. The drawings are objected to because the lines in Figure 1 are not uniformly thick, well defined, clean and durable as noted in the attached "Notice of Draftsperson's Patent Drawing Review." A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful **process, machine, manufacture, or composition of matter**, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Applicant is advised that should claims 1-5 be found allowable, claims 6-10 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. The Examiner considers a "method" and a "process" to be directed to the same statutory class of patentable subject matter described in 35 U.S.C.101 cited above. In other words, the terms "method" and "process" are deemed interchangeable in referring to the statutory class of "process". When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in

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wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to claims 1 and 6, the present claim is vague and indefinite. The Applicant claims a process/method but fails to recite all of the steps involved in the process. Instead, the Applicant recites components (e.g. a questionnaire, a comparison, the generation). The Examiner suggests that the Applicant describe claimed process using a positive recitation of the steps in the process/method (e.g. "completing a health questionnaire by an individual"; "comparing the questionnaire. . ."; "generating a dietary supplement profile . . ."). It is also unclear whether the entire process recited in the claim is computer-implemented. Furthermore, the metes and bounds of the information included in the dietary supplement profile (i.e. the listing of the suggested nutrients) are indefinite. It is unclear to the Examiner whether the dietary supplement profile includes a listing of one, at least one, or a plurality of the items listed in the claim. The phrase "other nutritional supplements" also renders the claim indefinite. Which "other nutritional supplements" are included in the scope of the

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claimed method? Furthermore, terms indicating the purported merits of the Applicant's invention (e.g. "for *optimal* health and wellness") should not be included in the claim language.

In reference to claims 2,3, 7, and 8, the present claims are vague and indefinite. It is unclear to the Examiner which element or step in the respective independent claims is being modified by the information in the present dependent claims. Who is adding the information? To what is this information added (i.e. a database or a copy of the final dietary supplement profile?) Where do these steps fit into the claimed process? (i.e. before generating the dietary supplement profile or after?)

In reference to claims 4 and 9, the present claims are vague and indefinite. It is unclear to the Examiner which element or step in the respective independent claims is being modified by the information in the present dependent claims. Is the list of commercially available products part of the dietary supplement profile (i.e. "wherein the dietary supplement profile further comprises a list of. . .")? Alternatively, does the method/process of claim 1 (or 6) further comprise the step of: "providing a list of commercially available products"? (i.e. is this a separate and distinct step from generating the dietary supplement profile in the claimed process/method?)

In reference to claims 5 and 10, the present claims are vague and indefinite. It is unclear to the Examiner which element or step in the respective independent claims is being modified by the information in the present dependent claims. Does the method/process of claim 1 (or 6) further comprise the step of: "providing a plan for

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weight management" ? (i.e. Is this a separate and distinct step?) Or is the plan for weight management part of the dietary supplement profile?

NOTE: In light of the extensive 112 2nd problems, the examiner is interpreting the claims and applying prior art as best as possible using these interpretations. These interpretations of claim language are for examination purposes only.

NOTE: The following art rejections assume that the subject matter of claims 6-10 will be amended to recite subject matter that is patentably distinct from the method of claims 1-5. The art rejections are provided herein below for the Applicant's consideration on the condition that the Applicant properly direct the subject matter in claims 6-10 toward a patentably distinct invention in the next communication sent in response to the present Office Action.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application

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being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claim 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Summerell et al. (US Patent No. 5,937,387)

In reference to claim 1 and 6, Summerell et al teach a method for customizing a personal wellness plan for an individual comprising:

- completing a health questionnaire by the individual; (Figures 4-6; col. 9, lines 15-31)
- comparing the information gathered from the questionnaire to a standard health profile in a computer database; (col. 11, lines 18-29)
- generating a dietary supplement profile based on the individual's health information, said dietary supplement profile including a recommendation for the individual to take at least one of the following nutrients: vitamins, minerals, amino acids, enzymes and herbs. (Figures 18-25)

Summerell et al teach a method and system for providing a personalized health and fitness profile for an individual. The individual completes a questionnaire relating to his/her overall health. The results from the individual's questionnaire are compared to a stored standard health profile which is based on individuals of comparable age and health risk. The system then generates health recommendations for the user including suggestions on nutritional supplements (e.g. vitamins and minerals) to take to improve the user's health. (i.e. dietary supplement profile) (see figures 18-25, especially 22-25)

In reference to claims 2 and 7, Summerell et al teach a method of calculating a dietary supplement profile further including the step of adding information provided from a physical examination. (col. 5, lines 62-67) A physician can input test result data (e.g. the individual's blood pressure) into the system. This information is used in determining the individual's wellness measurement and making health recommendations (i.e. dietary supplement profile).

In reference to claims 3 and 8, Summerell et al teach the method of claim 1 and 6 respectively, further comprising the step of adding information provided by laboratory studies. (col. 3, lines 19-39, col. 5, lines 62-67) The method disclosed by Summerell et al assesses individual wellness based on several risk factors, health parameters, and test results. The disclosed method uses these factors and results to develop a customized plan (i.e. dietary supplement plan). Some of the health parameters used to develop this customized wellness plan include total and HDL cholesterol levels and white blood cell counts. It is respectfully these data items are results that would be provided by laboratory studies. (i.e. blood work/ blood counts.)

In reference to claims 4 and 9, Summerell et al teach a method wherein the dietary supplement profile also includes a list of commercially available products that provide the suggested dietary supplements. (Figures 24-25) In addition to providing nutritional recommendations, the output of the disclosed system also details which products (e.g. fruits, vegetables, artificial vitamin supplements) provide the suggested nutrients. It is respectfully submitted the food products and artificial nutritional supplements are commercially available products.

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In reference to claims 5 and 10, Summerell et al teach a method wherein the dietary supplement profile also includes recommendations for weight management. (i.e. a weight management plan) (Figure 24). The sample recommendation details in the figure suggest a weight loss target for individuals with certain health problems (e.g. high blood pressure) and also explain the health benefits of weight loss and weight maintenance.

Remarks

12. It is called to applicant's attention that if a communication is deposited with the U.S. Postal Service and mailed to the Office by First Class Mail before the reply time has expired, applicant may submit the reply with a "Certificate of Mailing" which merely asserts that the reply is being mailed on a given date. So mailed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, DC 20231
on _____(date).

Typed or printed name of person signing this certificate

Signature_____

Date_____

13. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or

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agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

14. Applicant is also advised to review information regarding the patent process on the Patent's Office's website: www.uspto.gov. In addition to being able to download a copy of the Manual of Patent Examining Procedure (MPEP), the Applicant may also access required forms and useful information regarding fees and patent prosecution.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Shrive (US Patent No. 4,499,064) teaches a laboratory assay to determine the nutritional needs of an individual.
- Fuller et al (US Patent No. 4,464,122) teach a system for providing a health summary for an individual based on questionnaire results.
- Minturn et al (US Patent No. 5,692,501) teaches a system and method for providing a personal wellness assessment based on clinical test results.

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- Caple et al (WIPO No. WO 99/04043) teach a system and method of transmitting patient analysis and proposed treatment options between health care providers and patients (i.e. telemedicine).

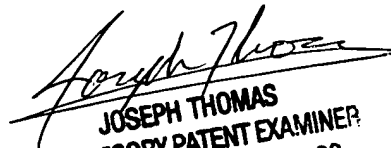
16. The Applicant is reminded of the shortened statutory period for response to the present Non-Final Office Action. A summary of statutory time periods is provided in "Period for Reply" section of the attached Office Action Summary sheet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703)305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

RLP
March 8, 2002


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100